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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/396,407      | 09/15/1999  | DAVID H. KOIZUMI     | 2207/6657           | 7402             |

7590 12/16/2003

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| EXAMINER |
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AZARIAN, SEYED H

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| ART UNIT | PAPER NUMBER |
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2625

DATE MAILED: 12/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/396,407

Applicant(s)

KOIZUMI, DAVID H.

Examiner

Seyed Azarian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 August 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 15 September 1999 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

1. In view of the appeal brief filed on 8/8/2003, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (a) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (b) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

**Claim Rejections - 35 USC § 103**

2. Following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-30, are rejected under 35 U.S.C. 103(a) as being unpatentable over Inokuchi (U.S. patent 3,819,857) in view of Taguchi et al (U.S. 5,215,397).

Regarding claim 1, Inokuchi discloses an apparatus for storage of information, comprising: magnetic ink having a stored information signal (Fig. 10, column 6, lines 22-30, the outputs of three bits from comparators 104, are temporarily "store" in a first register).

However Inokuchi fail to disclose "magnetic ink substance". On the other hand Taguchi et al in the same filed of magnetic ink teaches (column 3, lines 6-17, the writing means may be means to draw lines using ink which includes a magnetic substance and the hand writing detection means may be a magnetic sensor).

Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention was made to modify Inokuchi invention according to the teaching of Root et al because by providing data information, which can easily transportable among computer system, it implements in unique identification and description to user for authentication and accuracy.

Regarding claim 2, Inokuchi discloses the magnetic ink of claim 1, wherein the stored information signal (column 7, lines 32-40, refer to input signal and sine waveform).

Regarding claim 3, Inokuchi discloses, the magnetic ink of claim 1, wherein the stored information signal includes a digital information signal (column 3, lines 31-40, refer to digital output).

Regarding claim 4, Inokuchi discloses the magnetic ink of claim 1, wherein the stored information signal includes a time-varying frequency signal (column 6, lines 8-17, refer to time delay).

Regarding claim 5, Inokuchi discloses a magnetic information storage structure, comprising: a surface; and magnetic ink applied to the surface, said magnetic ink magnetized such as to contain an encoded information signal (column 3, lines 64-67, refer to encoding).

Regarding claim 6, Inokuchi discloses, a magnetic ink encoding stylus, comprising: a pen point adapted to apply magnetic ink to a surface (column 9, lines 1-7, refer to surface), and a magnetic ink write head coupled to the pen point and adapted to apply a varying magnetic flux to

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the magnetic ink as it is applied by the pen point to the surface (column 3, lines 46-52, refer to magnetic flux).

Regarding claim 7, Inokuchi discloses, the apparatus of claim 6, wherein the magnetic ink write head includes, a magnetic field generator, and a magnetic shield (abstracts refer to magnetic rod and magnetic coil).

Regarding claim 8, Inokuchi discloses the apparatus of claim 7, wherein the magnetic field generator includes a magnetic coil (column 7, lines 49-56, refer to sensing coil).

Regarding claim 9, Inokuchi discloses the apparatus of claim 8, wherein the magnetic coil is a wire coil (Fig. 2A and 2B, refer to wire coil).

Regarding claim 18, Inokuchi discloses the apparatus of claim 17, further comprising a direction sensor coupled to the encoding electronics (column 3, lines 53-60, refer to magnetic direction).

Regarding claim 20, Inokuchi discloses a computer system, comprising:  
A computer, including processor a memory coupled to the processor and external bus coupled to the processor and magnetic ink encoding stylus (see claims 1 and 6 also Fig. 10, column 6, lines 22-29, coded signal transmitted to an input device of an electronic computer).

Regarding claims 10-17 and 19, it recites similar limitation as claims 1-8, are similarly analyzed.

Regarding claims 21-24, it recites similar limitation as claims 1 and 6, are similarly analyzed.

Regarding claims 25-30, it recites similar limitation as claims 1, 4 and 20, are similarly analyzed.

**Contact Information**

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Seyed Azarian whose telephone number is (703) 306-5907. The examiner can normally be reached on Monday through Thursday from 6:00 a.m. to 7:30 p.m. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bhavesh Mehta, can be reached at (703) 308-5246.

**Any response to this action should be mailed to:**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306, (*informal* or *draft* communications, should be clearly labeled to expedite delivery to examiner).

**Hand delivered responses** should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application should be directed to T.C. customer service office whose telephone number is (703) 306-0377.

Seyed Azarian

Patent Examiner

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December 8, 2003

  
TIMOTHY M. JOHNSON  
PRIMARY EXAMINER